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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,371	06/27/2001	Yutaka Onozawa	1217-010927	5541

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Russell D. Orkin
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818

EXAMINER

EGAN, BRIAN P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 09/23/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,371

Applicant(s)

ONOZAWA ET AL.

Examiner

Brian P. Egan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-2, 13, and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The aforementioned claims contain the phrase “composed of.” The transitional phrase “composed of” has been interpreted in the same manner as either “consisting of” or “consisting essentially of,” depending on the facts of the particular case. See *AFG Industries, Inc. v. Cardinal IG Company*, 239 F.3d 1239, 1245, 57 USPQ2d 1776, 1780-81 (Fed. Cir. 2001). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See, e.g., *PPG*, 156 F.3d at 1355, 48 USPQ2d at 1355. If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of,” applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ

256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989).

Here, there is an absence of a clear indication in both the specification and the claims of what the basic and novel characteristics actually are, thereby rendering the claim to be interpreted had the transitional phrase “comprising” been used. None of the figures demonstrate a multilayered base composed exclusively of the same resin films laminated – each figure depicts resinous base materials (acrylic resin, PC, PMM, PET, etc.) all separated by adhesive layers, which themselves are resinous. Therefore, the claimed limitation wherein the multi-layered base is composed of the same resin films is non-enabling – even when interpreting the claim using the “comprising” phraseology.

3. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The phrase, “impact resistant,” is not distinguishable from the phrase, “weather-resistant.” In reference to Table 1 on page 27 of the applicants disclosure, the applicants specifically list “resistance to scratching” as a testing procedure under weather-resistance. A material that is resistance to scratching is inherently resistant to an impact. Furthermore, wind, rain, hail, snow, etc. are all forms of weather wherein some level of impact is involved. Therefore, the Examiner suggests rewording the claim such that the “impact resistant” layer is clearly distinguishable from the “weather resistant” layer – otherwise, a single layer of resinous material that is weather-resistant will also be considered to be impact resistant. Clarification and/or correction are required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1, 3-12, 14-20, and 22-28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP-11-309813.

JP '813 discloses a hard coat film comprising a silicone-based hard coat layer provided on one side of a multi-layered base composed of a plurality of different laminated resin films (note that all film layers adjacent the hard coat layer are considered as part of a base structure) (pgs. 2-7, paragraphs [0003-0010]). The base comprises a weather-resistant resin film (p.2, paragraph [0003]), thereby inherently impact resistant, wherein the base film comprises films made from materials such as PET, PC, acrylic resins, polyester system resins, polyurethane resins, and butyral resins (p. 3, paragraph [0005] and p. 5, paragraph [0008]). The hard coat layer is provided on the weather-resistant resin film wherein the weather-resistant resin film comprises an ultraviolet absorber (p. 3, paragraph [0005]). A release sheet is provided via an adhesive layer on a side made of the multi-layered base opposite to a side provided with the silicone-based hard coat layer (pgs. 6-7, paragraph [0010]). The hard coat film is stuck on

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external surfaces of window panes and plastic boards for windows (pgs. 6-7, paragraph [0010]).

Note, however, that the claimed limitation, “the hard coat film used for being stuck on the external surfaces...,” is merely an intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Marsham*, 2 USPQ 2d 1647 (1987).

6. Claims 1, 3-12, 14-20, and 22-28 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Russell et al. (#6,391,400).

Russell et al. disclose a hard coat film comprising a silicone-based hard coat layer (Col. 36, lines 16-26) provided on one side of a multi-layered base composed of a plurality of the same or different laminated resin films (see Figs. 3(c and e)). Given that the substrate layers are selected from multiple different materials, the embodiments wherein there are multiple substrates (figs. 3(a-e), 4(c-f)), the substrates would be of either the same or different composition (Col. 17, line 40 to Col. 18, line 17). The base comprises film materials such as PMM and PC that inherently exhibit weather-resistant resin film (Col. 17, lines 53-55) and PET film that inherently exhibits impact resistant (Col. 17, lines 66-67; Col. 36, lines 11-15). The hard coat layer is provided on the weather-resistant resin film wherein the weather-resistant resin film comprises an ultraviolet absorber (Col. 18, lines 18-23). A release sheet is provided via an adhesive layer on a side made of the multi-layered base opposite to a side provided with the silicone-based hard coat layer (Col. 28, lines 62-66). The hard coat film is stuck on external surfaces of window panes and plastic boards for windows (Col. 34, lines 62-66). Note, however, that the claimed limitation, “the hard coat film used for being stuck on the external surfaces...,” is merely an

intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Marsham*, 2 USPQ 2d 1647 (1987).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-12, 14-20, and 22-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hojnowski (#5,956,175) in view of Onozawa et al. (#6,103,370).

Hojnowski teach a substrate comprising a hard coat film layer provided on one side of a plurality of the same or different resin film laminated (see Abstract; Fig. 1). The multilayered based contains a weather-resistant resin (Fig. 1, #16; Col. 5, lines 57-58) and an impact resistant resin film (Fig. 1, #10; Col. 5, lines 44-52). The hard coat layer is provided on the weather-resistant resin film of the multi-layered base (Fig. 1, #18). The weather-resistant resin film further comprises ultraviolet absorbers (Col. 5, lines 57-58; Col. 6, lines 40-41) and is made of PET, PC, or PMM (Col. 5, lines 52-56). The substrate comprises an adhesive layer on the opposite side of the multilayered base than the hard coat film such that the substrate is able to be affixed to surfaces such as window panes or plastic boards for windows (Col. 5, lines 20-23).

Note, however, that the claimed limitation, "the hard coat film used for being stuck on the

external surfaces...,” is merely an intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Marsham*, 2 USPQ 2d 1647 (1987).

Although Hojnowski does not explicitly state that the hard-coat film layer is silicon-containing, Hojnowski states that, “the scratch and abrasion resistant hard coat (18) may be selected from any of a number of hard coat materials conventionally employed and well known in the window film industry (Col. 6, lines 42-46).” It is notoriously well known in the art to use silicon-containing hard coat films in the window film industry as evidenced by Onozawa et al. (see Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have used a silicone-containing hardcoat film on the substrate detailed by Hojnowski since silicone-containing hardcoat films are notoriously well known in the art and exhibit excellent hard coat properties while also exhibiting anti-fouling, anti-bacterial, and anti-glare properties as evidenced by Onozawa et al. (see Abstract).

Hojnowski fails to teach the use of a release liner affixed to the adhesive layer.

Onozawa et al., however, teach a hart coat sheet laminated to a base wherein the base comprises an adhesive layer and a release liner on the opposite side of the base from the hard coat layer (Col. 3, line 63 to Col. 4, line 2). Onozawa et al. teach the use of a release liner for the purpose of protecting the adhesive surface prior to affixing the substrate to the desired end product (Col. 4, lines 36-38). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have provided an adhesive layer on the back of a window film substrate with a release liner for the purpose of

protecting the adhesive prior to affixing the window film to the desired end product as taught by Onozawa et al.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Hojnowski by providing the adhesive layer with a release liner as taught by Onozawa et al. in order to protect the adhesive prior to affixing the film to the desired end product.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

BPE
September 13, 2002


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772 9/18/02